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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/172,577 10/13/98 HALL

R BLANKET-358

EXAMINER

PM82/1110

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PORT HURON MI 48060

KIM, C

ART UNIT

PAPER NUMBER

3682

DATE MAILED:

11/10/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/172,577**

Applicant(s)  
**Hall et al.**

Examiner  
**Chong H. Kim**

Group Art Unit  
**3682**



☒ Responsive to communication(s) filed on Oct 13, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 16-37 is/are pending in the application.

Of the above, claim(s) 21-37 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 16-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 16-37 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 16-20, drawn to the method of providing inert gas blanket to a machine having oleaginous liquid as shown in Figs. 1 and 3, classified in class 184, subclass 6.24.
  - II. Claims 21-36, drawn to the apparatus of protected item with inert gas, classified in class 422, subclass 41.
2. The inventions are distinct, each from the other because of the following reasons: ~~Inventions~~ I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as oil tankers.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. If applicant elects the invention of group II, then the applicant is further required to make an election of species within invention II. Invention II contains claims directed to the following patentably distinct species of the claimed invention:

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Species A - Figs. 1 and 3;

Species B - Fig. 2;

Species C - Fig. 4.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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5. During a telephone conversation with Mr. Christopher Rudy on Nov. 3, 1999 a provisional election was made with traverse to prosecute the invention I, claims 16-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

***Claim Rejections - 35 USC § 112***

7. Claims 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 recites the alternative language "or" in line 2. It is indefinite because an alternative language does not clearly claim the subject matter.

Claim 18 recites the alternative language "or" in line 2. It is indefinite because an alternative language does not clearly claim the subject matter.

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Claim 20 recites the limitation "it is necessary to change the oil only after twenty thousand miles of use or more" in lines 3-4. It is indefinite because it is not clear whether the oil is changed or not.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kopel, U.S. Patent 4,561,393.

Kopel shows, in Figs. 1 and 2, and discloses in column 1 lines 21-31, column 2 lines 63-65, and column 5 lines 53-56, a method for controlling oxidative degradation of an oleaginous liquid substance (oil) 124 in a generally enclosed space 140 in a working machine (internal combustion engine, see column 1 lines 11-12), which comprises providing an inert gas (nitrogen, see column 4 lines 64-65) blanket to the space 140.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kopel in view of Gast, Jr., U.S. Patent 5,649,995.

Kopel shows, as discussed above in the rejection of claims 16-18, a method of providing nitrogen blanket into the enclosed space to control oxidation of the engine oil, but fails to show the membrane-containing device for separating the inert gas from air.

Gast, Jr. shows, in Figs. 3 and 4, a method for providing a membrane-containing device 12 to separate nitrogen from air through membrane 54.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the membrane-containing device of Gast, Jr. to supply the inert gas of Kopel in order to provide higher purity nitrogen so that aging of a certain organic material can be controlled.

### *Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Inert gas being used to extend life.

Solomon, U.S. Patent 4,066,401

Dunegan, U.S. Patent 4,400,123

Inert gas being used in exhaust system.

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Hasegawa et al., U.S. Patent 3,982,395

Inert gas being used to prevent leakage or explosion.

Geichman, U.S. Patent 3,751,699

Kober, U.S. Patent 3,777,928

Oiestad, U.S. Patent 3,899,099

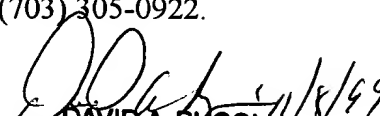
Inert gas being used for controlling oxidation.

Zehler et al., U.S. Patent 4,601,840

Inert gas being used in internal combustion engine.

Bahrle et al., U.S. Patent 4,393,922

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chong H. Kim whose telephone number is (703) 305-0922.

  
DAVID A. BUCCI  
PRIMARY EXAMINER

CHK *Chr*

November 4, 1999